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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/847,889

05/03/2001

John R. Hind

RSW920010017US1

7519

7590

06/01/2005

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EXAMINER

HECK, MICHAEL C

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,889

Applicant(s)

HIND ET AL.

Examiner

Michael C. Heck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/03/01</u> . | 6) <input type="checkbox"/> Other: _____ |

✓

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 03 May 2001. Claims 1-26 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: S8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

- On page 9, line 20, delete "In Step S10", and insert -- In Step **S8** --. Please see the drawing objection above.

The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, **claims 1 and 8** only recite an abstract idea. As to **claim 1**, the recited steps of storing transaction information associated with a plurality of different persons; collecting product

information from RFID-tagged items carried on a particular person; correlating the product information with the transaction information; and identifying characteristics associated with the particular person based on results of the correlating step does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for identifying characteristics associated with a particular person, therefore, is deemed to be directed to non-statutory subject matter. As to **claim 8**, the recited steps of collecting RFID tag information from the RFID-tagged items carried on the person; associating the person based on the collected RFID tag information as the person roams through roaming areas; and tracking the person in the roaming areas based on results from the associating step does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for tracking a person based on RFID-tagged items carried on the person, therefore, is deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implications of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any

structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces identified characteristics associated with a particular person and a means of tracking a person based on RFID-tagged items carried on the person (i.e., repeatable, useful and tangible).

Looking at the claims as a whole, nothing in the body of the claims recite any structure or functionality to suggest that a computer performs a task. While claim 1 recites RFID-tagged items, this amounts to only identifying the characteristics of the item that is used to supply product information where nothing is done (i.e., computing) to breathe life into the invention. Also, claim 8 recites RFID tag information is collected, however RFID only amounts to an identifying characteristic of the tag where nothing is done (i.e., computing) to breathe life into the invention.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, the same rejection as stated above for claims 1 and 8 applies to **claims 2-7 and 9-10**.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (Jones, Working Without Wires, Industrial Distribution, August 1999, p. M6, M8-M9 [PROQUEST]) in view of DeTemple et al. (U.S. Patent 5,995,015). Jones discloses an identification and tracking of persons using RFID-tagged items in store environments comprising:

- **[Claim 1]** storing transaction information associated with a plurality of different persons (Para 10, Jones teaches RFID enables retailers to become better acquainted with their customers through the collection and storage of vital information on buying patterns.);
- collecting product information from RFID-tagged items carried on a particular person (Para 10, Jones teaches loyalty cards: Shell, Mobile, and other gasoline vendors are giving customers RFID tags that provide instant credit authorization at the pump. In addition to speeding purchases and making transactions more efficient, RFID enables retailers to become better acquainted with their customers through the collection and storage of vital information on buying patterns. The Examiner interprets the RFID-tagged item is the loyalty card that is carried by the customer.);
- correlating the product information with the transaction information (Para 10, Jones teaches that in addition to speeding purchases and making transactions more efficient, RFID enables retailers to become better acquainted with their customers through the collection and storage of vital information on buying patterns. The Examiner interprets product information, i.e., buying patterns, relates to the transactions since that is how the information is received.); and
- **[Claim 8]** collecting RFID tag information from the RFID-tagged items carried on the person (Para 10, Jones teaches loyalty cards: Shell, Mobile, and other gasoline vendors are giving customers RFID tags that provide instant credit authorization at the pump. The Examiner interprets the RFID-tagged item is the loyalty card that is carried by the customer.);

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As to claim 1, Jones fails to teach identifying characteristics associated with the particular person based on results of the correlating step. As to Claim 8, Jones fails to teach associating the person based on the collected RFID tag information as the person roams through roaming areas; and tracking the person in the roaming areas based on the results from the associating step. Jones does teach new advanced products are designed to read at longer ranges with the intent of tracking people and assets, wherever they may roam (Para13). DeTemple et al. teach a means to read previously recorded demographic information about the customer associated with the sales transaction in progress at a specific POS terminal (col. 8, lines 18-27). A tracking transmitter for tracking the path taken by a customer while shopping is used where data on the products purchased and the identification of the shopping card are linked to the path taken by the shopping cart in the store. Customer card information comprises customer identification (col. 9, lines 9-44). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the personal characteristics identifying, associating and tracking step with the teachings of Jones since Jones teaches collection and storage of vital information on buying patterns (Para 10). Analyzing customer information allows merchants to be better prepared to meet the customer's needs. Jones teaches aggressive marketing programs as a result of user awareness of RFID (Para 9). DeTemple et al. teach most modern retail stores implement some method of tracking the path customers take while shopping, to determine shopping habits and effects of advertising, product placement, etc. (col. 2, lines 54-63). Therefore, Jones and DeTemple et al. teach using customer information

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to be better prepared to meet the customer's needs. Jones teaches a loyalty card (Para 10) and DeTemple et al. teach the demographic information is contained in a card issued to the customer (col. 8, lines 18-27). Both Jones and DeTemple et al. are collecting information about customers using cards, therefore there is motivation to combine and a reasonable expectation of success. All the claim limitations are either suggested or taught by Jones and DeTemple et al..

- **[Claim 2]** wherein the identifying step identifies demographics of the particular person based on the results of the correlating step (DeTemple et al.: col. 8, lines 18-27, DeTemple et al. teach a means to read previously recorded demographic information about the customer associated with the sales transaction in progress at a specific POS terminal.).
- **[Claim 3]** wherein the identifying step identifies the exact identify of the particular person based on the results of the correlating step (DeTemple et al.: col. 8, lines 18-27 and col. 9, lines 21-44, DeTemple et al. teach a means to read previously recorded demographic information about the customer associated with the sales transaction in progress at a specific POS terminal. Customer card information comprises customer identification.).
- **[Claim 4]** tracking the particular person as the particular person roams through roaming areas using the identified characteristics and the product information associated with the particular person (Jones: Para 13, Jones teaches new advanced products are designed to read at longer ranges with the intent of tracking people and assets, wherever they may roam. DeTemple et al.: col. 9, lines 9-44, DeTemple et al. teach a tracking transmitter for tracking the path taken by a customer while shopping. Data on the products purchased and the identification of the shopping card are linked to the path taken by the shopping cart in the store.).
- **[Claim 5]** providing targeted advertising using information obtained from said tracking step (DeTemple et al.: col. 2, line 65 to col. 3, line 3, DeTemple et al. teach an integrated pricing, advertising, and tracking system for displaying current pricing information as well as advertising information on remote display terminal, and tracking customer activity throughout a store.).
- **[Claim 6]** wherein the product information includes at least one of the following: a SKU number associated with a product and a unique serial number identifying the product (Jones: Para 3 and 7, Jones teaches passive

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RFID tags, embedded in products, provide a disposable "electronic" manifest at the item or package level. RFID tags are seen as a replacement for bar codes. The Examiner interprets Jones to teach a SKU number associated with a product.).

- **[Claim 7]** wherein the RFID-tagged items include RFID tags incorporated therein and carrying the product information (Jones: Para 3 and 7, Jones teaches passive RFID tags, embedded in products, provide a disposable "electronic" manifest at the item or package level. RFID tags are seen as a replacement for bar codes.).
- **[Claim 9]** wherein, in the associating step, the person is associated with the collected RFID tag information without using any information about the exact identity or purchase records of the person (Jones: Para 12 and 13, Jones teaches RFID systems are capable of detecting the passage of assets past fixed points in a fixed process. For example, RFID readers as part of a manufacturing process will read all tags passing a particular point. New advanced products are designed to read at longer ranges with the intent of tracking people and assets, wherever they may roam. The Examiner interprets the exact identity or purchase records of a person are not needed to track assets.).
- **[Claim 10]** wherein the RFID-tagged items include RFID tags incorporated in the RFID-tagged items, said RFID tags carrying product information (Jones: Para 3 and 7, Jones teaches passive RFID tags, embedded in products, provide a disposable "electronic" manifest at the item or package level. RFID tags are seen as a replacement for bar codes.).

Claims 11-26 substantially recite the same limitations as that of claims 1-10 with the distinction of the recited methods being a system and computer readable medium.

Hence the same rejection for claims 1-10 as applied above applies to claims 11-26.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boyd (U.S. Patent 6,484,148) discloses an electronic advertising device and method of using the same.
- Smith (U.S. Patent 5,563,423) discloses location tracking of individuals in physical spaces.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael C. Heck whose telephone number is (571) 272-6730. The Examiner can normally be reached Monday thru Friday between the hours of 8:30am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 273-6729.

Any response to this action should be mailed to:

**Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Or faxed to:

(703) 872-9306

[Official communications; including After Final communications labeled "**Box AF**"]

(571) 273-6730

[Informal/Draft communication, labeled "**PROPOSED**" or "**DRAFT**"]

mch
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27 May 2005


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